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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,771	11/04/2003	Marlene C. Schwarz	12013/53907	5897

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EXAMINER

LAMB, BRENDA A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,771

Applicant(s)

Schwarz et al

Examiner

LAMB

Group Art Unit

1734

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 11/04/03, 12/09/03 and 12/19/03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-8 and 23-30 is/are pending in the application.
- Of the above claim(s) 23-25 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-8 and 26-30 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 11/04/03 and 12/09/03 ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8 and 26-30, drawn to apparatus, classified in class 118, subclass 303.
- II. Claims 23-25, drawn to method, classified in class 623, subclass 1.

The inventions are distinct, each from the other because:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the product as claimed can be made by another and materially different apparatus such as a rotating tumbling drum.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation between Examiner Kolb-Michener and Attorney Fred Grasso on 6/4/2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-8 and 26-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-25 are withdrawn from further

consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claims 27 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation in claim 27 of a source of therapeutic which separate from the source of coating set forth in independent claim 26 is confusing since source of coating includes any material which can coat a substitute including that which is therapeutic.

Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specification fails to teach the apparatus is comprised of a coating area, vibration source, source of coating and screen positioned between the vibration source and coating area wherein the vibration source is a moving convey or belt.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the coating nozzle positioned beneath the vibration source located in the coating chamber must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: coating nozzle positioned beneath the vibration source.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 3-6, 8 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by 4,919,973 by Alkan et al.

Alkan et al teaches the design of a coating apparatus comprised of a coating area of container 1 above screen 3, having an entrance and exit for air flowing there through; a vibration source (elements 4 to 9) positioned beneath the coating area; a

source of coating (elements 11-13) having an exit point in fluid communication with the coating area; and a screen 3 positioned between the vibration source and coating area. Alkan et al's coating area is capable of accepting materials within the scope of the claim. Thus Alkan et al teaches every claimed element of claim 26. With respect to claim 1, the same rejection applied to claim 26 is applied here. Alkan et al shows a portion of the vibration source is positioned within the coating chamber 1. Alkan et al vibration source is capable of suspending a substrate in the coating chamber given Alkan et al teaching that amplitude and frequency of vibration of the mesh and velocity of dry air is adjustable dependent on quantity and size of substrate to be coated. Alkan et al teaches every element of the apparatus set forth in claim 1. With respect to claim 3, Alkan et al teaches the vibration source is an acoustic diaphragm. With respect to claim 4, as discussed above, Alkan et al teaches the coating source includes a nozzle coupled to a coating inlet or a coating source. With respect to claim 5, Alkan et al shows the vibration source is positioned below the screen 3. With respect to claim 6, the Alkan et al vibration source is capable of suspending a substrate within the scope of claim given Alkan et al teaching that amplitude and frequency of vibration of mesh and velocity of air is adjustable. With respect to claim 8, Alkan et al teaches at column 3 lines 18-25 a controller to control the acoustic diaphragm so as to vibrate the diaphragm at the desired frequency and the apparatus inherently included a power source to provide the motive force for the loud speaker to work.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alkan et al in view of Holt.

Alkan et al is applied for the reasons noted above. Alkan et al fails to teach a coating filter coupled to the coating chamber. However, it would have been obvious to modify the Alkan et al apparatus by providing a coating filter which is operatively coupled to the coating chamber through the coating nozzle such as taught by Holt for the obvious reason to prevent plugging of the coating nozzle.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Garner.

Garner teaches the design of a coating apparatus comprised of the following elements: a coating chamber (elements 10, 14); a vibration source (elements 25-30) positioned within the coating chamber; a coating source which includes element 16 positioned to introduce coating into the coating chamber. Garner vibration source is capable of suspending a substrate within the scope of the claim within the chamber. Thus Garner teaches every structural element of the apparatus set forth in claim 1. With respect to claim 3, Garner teaches the vibration source is comprised of a plate.

Claims 26 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by McKinley et al.

McKinley et al teaches an apparatus for coating articles comprising the following elements: a coating area (area above planar surface 10); a vibration source 11 positioned beneath the coating area; a source of coating having an exit point from orifice of nozzle 20 in fluid communication with the coating area; and a screen 24 positioned between the vibration source and coating area. McKinley et al coating area is capable of accepting medical implants for implantation within the body of a patient.

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With respect to claim 28, McKinley et al shows the coating area is partially enclosed space defined by baffle 14. McKinley et al shows the vibration source configured to urges the article from the entrance to the exit of the confined space.

Claims 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alkan et al in view of Opalski.

Alkan et al is applied for the reasons noted above. However, it would have been obvious to modify the Alkan et al apparatus to connect the coating nozzle to a source of therapeutic material since Opalski spray coating medical devices with coating that includes therapeutic agents and other coating components (see column 12 lines 48-49 and lines 1-5). Further the recitation in claim 30 that the coating and therapeutic material mix prior to the coating area has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C. D. 172; 388 O.G. 279. it has been held that the term "intergral" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973).

Claims 27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKinley et al in view of Opalski.

McKinley et al is applied for the reasons noted above. However, it would have been obvious to modify the McKinley et al apparatus to connect the coating nozzle to a

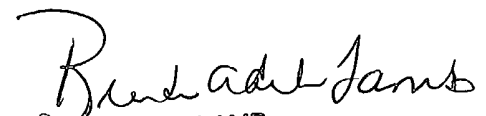
source of therapeutic material since Opalski spray coating medical devices with coating that includes therapeutic agents and other coating components (see column 12 lines 43-49 and lines 1-5). The function recitation in claim 30 that the coating and therapeutic material mix prior to the coating area has not been given patentable weight because it is narrative in form. In order to be given patentable weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC § 112, 6th paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C. D. 172; 388 O.G. 279. it has been held that the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alkan et al 4,919, 973 in view of Wurster 3,253,944.

Alkan et al is applied for the reasons noted above. Alkan et al fails to teach the coating nozzle is positioned below the screen. However, it would have been obvious to modify the Alkan et al apparatus by substituting its spray nozzle with that of Wurster for the taught advantage of uniform coating of particulates.

Any inquiry concerning this communication should be directed to Brenda A. Lamb at telephone number 571-272-1231. The examiner can normally be reached on Monday thru Tuesday and Thursday thru Friday with alternate Wednesdays off.

Lamb/tgd


BRENDA A. LAMB
PRIMARY EXAMINER